Supreme Court, U.S.
FILED
SEP 25 1996
CLERK

No. 96-265

IN THE

Supreme Court of the United States

OCTOBER TERM, 1996

ROBERT SUNENBLICK,

Petitioner,

vs.

ANDRE HARRELL, ANDRE HARRELL, INC., MCA, INC., and MCA RECORDS, INC.,

Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT

RESPONDENTS' BRIEF IN OPPOSITION

STEPHEN F. HUFF
ANDREW H. BART
Counsel of Record
PRYOR CASHMAN SHERMAN & FLYNN
Attorneys for Respondents
410 Park Avenue
New York, New York 10022
(212) 421-4100

TABLE OF CONTENTS

	Page
Table of Authorities	iii
Summary of Argument	1
Argument The Petition Should Be Denied	2
Point I Misstatements In The Petition	2
Point II This Case Is Limited In Its Impact	4
Conclusion	7

TABLE OF AUTHORITIES

Cases: **Page**

Lang v. Retirement Living Pub. Co., Inc., 949 F.2d 576 (2d Cir. 1991)..... 3

Nikon, Inc. v. Ikon Corp., 803 F. Supp. 910 (S.D.N.Y. 1992), *aff'd*, 987 F.2d 91 (2d Cir. 1993)..... 5

Polaroid Corp. v. Polarad Electronics Corp., 287 F.2d 492 (2d Cir.), *cert. denied*, 368 U.S. 820 (1961)..... 1, 2, 3, 4, 5

SUMMARY OF THE ARGUMENT

The Petition for certiorari in this case is based on Petitioner's blatant misrepresentation that the District Court below decided that there was no likelihood of confusion based solely on an analysis of alleged confusion by end users or consumers. In fact, the District Court fully examined each and every one of the factors set forth in *Polaroid Corp. v. Polarad Electronics Corp.*, 287 F.2d 492 (2d Cir.), *cert. denied*, 368 U.S. 820 (1961) in finding that there was no likelihood that consumers will be confused as to the source of Petitioner's product. These findings were affirmed by the Court of Appeals for the Second Circuit. Moreover, in its analysis of actual confusion, the court carefully examined and rejected each of the instances of alleged confusion of retailers and wholesalers put forth by Petitioner, and thus Petitioner's claim that the District Court merely examined confusion of end purchasers is meritless. Finally, since as with any trademark case, the court's decision in this case is limited to the particular facts of this case, Petitioner's attempt to act as a spokesperson for businesses not before the District Court must also be rejected.

ARGUMENT

THE PETITION SHOULD BE DENIED

POINT I

MISSTATEMENTS IN THE PETITION

Pursuant to Rule 15 of this Court, Respondents submit this brief to assist the Court in deciding whether to exercise its discretionary jurisdiction in this matter.

First, the Petition is premised on a blatant misrepresentation of the holding of the District Court, which was affirmed by the Court of Appeals for the Second Circuit. Petitioner argues that the trial court's conclusion that there was "no likelihood that consumers will be confused as to the source of Sunenblick's products" was "premised on the view that in a Lanham Act action the only people whose confusion matters are end purchasers." However, this is a misstatement of the court's finding. The court's conclusion that there was no likelihood of confusion - reached after an exhaustive bench trial and submissions of extensive post-trial briefs - was based on the court's careful examination and balancing of every one of the factors set forth in Judge Friendly's decision in *Polaroid Corp. v. Polarad Electronics Corp.*, 287 F.2d 492 (2d Cir.), *cert. denied*, 368 U.S. 820 (1961). These factors are (1) the strength of the mark; (2) similarity of the marks; (3) competitive proximity of the marks; (4) probability that the senior user will enter the junior user's market in the future; (5) evidence of actual confusion; (6) defendant's good faith in adopting the mark; (7) quality of the products; and (8) sophistication of the purchasers.

The court's brief discussion of the relevant class of "consumers" was only within its examination of the fifth and eighth factors which examine whether the plaintiff has submitted evidence of actual confusion and whether consumers are sophisticated. While the court stated that given the type of protection that the Lanham Act provides, and the particular facts of this case, the relevant class of consumers under the "actual confusion" factor is the ultimate consumer, and not

retailers or wholesale buyers, the Court exhaustively considered each of the other *Polaroid* factors before rendering the decision.

Petitioner also misrepresents the basis of the trial court's finding that there was no actual confusion between the two marks at issue. In finding that Petitioner had failed to demonstrate any evidence of actual confusion, the court below correctly stressed that "the relevant confusion to be avoided is that which affects purchasing decisions, and not confusion generally" (*citing*, *Lang v. Retirement Living Pub. Co., Inc.*, 949 F.2d 576, 582-83 (2d Cir. 1991) and authorities cited therein). Thus, confusion that does not affect purchasing decisions is not actionable. Petitioner asserts that the District Court erroneously examined only the confusion of end purchasers. However, the record reflects that the court carefully considered each of Petitioner's so-called examples of confusion (App. at 22-25). The trial court's rejection of Petitioner's argument regarding actual confusion was based on its determination that there was absolutely no evidence of any deception as to a purchasing decision or diversion of sales. The court's finding that there was no evidence of confusion was not based merely on its determination that retailer confusion was not relevant, but rather on its determination that there simply was no evidence of retailer confusion in the record.[1] Thus, there was no error since the trial court examined each and every one of Petitioner's examples of alleged retailer confusion and correctly found that there was no actual confusion.

The other reference to end users as the most appropriate customers to consider was during the Court's discussion of sophistication of the customers. However, this factor even more strongly supports Respondents' position if one considers retailers and wholesalers instead of retail customers. Retailers

---

[1] Indeed, it is telling that Petitioner does not advise this Court that when Respondents' products are sold to wholesalers and retailers they are listed alphabetically in the UNI Distribution Catalog and the name "Uptown" does not appear.

and wholesalers are specialists in the market for recorded music and must be considered the most sophisticated of customers.

Finally, even if this Court were to entertain Petitioner's argument that the District Court's finding that the relevant class of consumers were end purchasers was erroneous, Petitioner has failed to demonstrate a basis for this Court to grant the Petition. Petitioner does not even assert that the court below deviated from the *Polaroid* analysis utilized by the Second Circuit. Petitioner has not demonstrated that the decision below is in conflict with the decision of another United States court of appeals on an important subject or that the court below decided an important federal question in a way that conflicts with a decision by a state court of last resort or any of the other "compelling reasons" set forth in Rule 10 of this Court's Rules. Petitioner merely requests yet another attempt to argue the very same issues raised, fully considered and rejected by both the District and Circuit Courts, and therefore its Petition must be denied.

POINT II

THIS CASE IS LIMITED IN ITS IMPACT

Notwithstanding that this case (as is every other trademark case which examines the fact-driven *Polaroid* factors in its determination of the likelihood of consumer confusion) is *sui generis*, Petitioner argues that the holding of the court below "effectively prevents recording companies, and especially small independent recording companies, from enforcing their trademark rights, i.e., effectively strips them of their trademark rights." Petition at 5. Petitioner also makes the sweeping statement that the court's interpretation of the Lanham Act "makes impossible for anyone in the recording business to ever protect his or her record label."

Again, this argument is premised on a misstatement of the court's holding below. At page 5 of his Petition, Petitioner quotes a passage from the District Court decision which states that Respondents' position, if taken to its extreme, would

result in a determination "that such marks can never receive protection under trademark law." The Court, in the very next sentence (not quoted by Petitioner) specifically rejects this position and states that "it is not prepared to go quite that far." Indeed, if a plaintiff record company brought suit against a defendant using the same name in the same genre of music and proffered a viable survey or other evidence of actual confusion, the result might be different. The court's decision in this case is limited to the particular facts of this case. Thus, Petitioner's self-serving and melodramatic prediction of the evisceration of trademark rights for all independent record label owners must be rejected.

Any case for trademark infringement, (including those brought by the owner of a record label), will involve an extensive factual analysis of *all* of the relevant *Polaroid* factors, which include, *inter alia*, the strength of the mark, similarity of the marks and proximity of the marks. It is the balancing of these factors as a whole which brings a court to its conclusion as to whether an appreciable number of consumers will be confused as to the source of the goods in question. Thus, the court's findings with respect to one of the *Polaroid* factors is in no way conclusive, as noted by the court below. (Petition App. At 15). "Each *Polaroid* factor must be considered in the context of the other factors, and no single factor may be dispositive of the likelihood of confusion." *Nikon, Inc. v. Ikon Corp.*, 803 F. Supp. 910 (S.D.N.Y. 1992), *aff'd*, 987 F.2d 91 (2d Cir. 1993). Thus, Petitioner's assertion that an allegedly incorrect determination of one factor forms the basis for a petition for a writ of certiorari is completely baseless.

Similarly, Petitioner's attempt to become the spokesperson for the interests of book publishers, movie studios and food distributors is a completely inappropriate argument on a petition for certiorari. This Court is not reviewing decisions to make global statements of legislative policy affecting cases that have never been brought. Rather, its jurisdiction is discretionary and is generally exercised only to reconcile conflicting decisions of different circuits (or of the highest state court and a federal circuit court) and for other compelling

reasons. Petitioner's frustration that due to the proper application of long-settled case law he was unable to convert the unintentional and non-damaging use of the name "Uptown Records" by another record company[2] into a multimillion dollar windfall is hardly the type of issue warranting the attention of this Court.

---

[2] Petitioner's assertion that "it is undisputed" that for most of the period between 1986 and 1991 Respondents knew of Petitioner's mark is *directly* contradicted by the finding by the District Court (App. 9) that from 1986 through 1991 "Harrell's products and those of Sunenblick were sold simultaneously without either party being aware of the existence of the other."

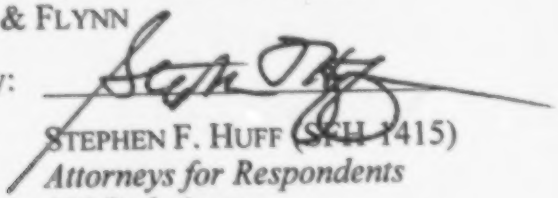
CONCLUSION

For the foregoing reasons, Respondents respectfully request that the Petition for a Writ of Certiorari be denied in all respects.

Dated: New York, New York
September 25, 1996

Respectfully submitted,

PRYOR, CASHMAN, SHERMAN
& FLYNN

By: 

STEPHEN F. HUFF (SFH 1415)
Attorneys for Respondents
410 Park Avenue
New York, New York 10022
(212) 421-4100

Of Counsel:
STEPHEN F. HUFF
ANDREW H. BART